

Application Number 09/733,302  
Response to Office Action mailed June 9, 2008

### **REMARKS**

This amendment is responsive to the Final Office Action dated June 9, 2008. By this Amendment, Applicants have amended claim 1. Claims 22, 23 and 29-41 were previously canceled. Claims 1-21 and 24-28 are pending. Reconsideration of the Application in light of the above amendments and following remarks is respectfully requested.

#### **Claim Rejection Under 35 U.S.C. § 112**

Claim 1-21 and 24 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to clarify the claimed subject matter. Applicants respectfully submit that claim 1 as amended particularly points out and distinctly claims the subject matter which applicant regards as the invention as required by 35 U.S.C. 112, second paragraph. Withdrawal of this rejection is therefore respectfully requested.

#### **Claim Rejection Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-21 and 24-31 under 35 U.S.C. 102(e) as being anticipated by Landsberger (US 6,113,599).

Applicants respectfully submit that Landsberger fails to disclose each and every feature recited in amended independent claims 1 and 25, as well dependent claims 2-21, 24 and 26-28, as required by 35 U.S.C. 102(e) and provides no teaching that would have suggested the desirability of modification to include such features.

With respect to independent claim 1, for example, Landsberger does not teach or suggest an expansion means ... for disengaging from the first transmitting means and the second transmitting means after the distraction is complete as recited in amended independent claim 1. Rather, Landsberger teaches an implantable device for lengthening of the mandible by distraction osteogenesis in which, once the desired distraction is obtained, the entire device remains implanted during the period of bone consolidation (approximately two to four months) before it is surgically removed (see, e.g., Landsberger at col. 6, lines 42-48; and col. 17, lines 42-45). Landsberger does not disclose or suggest that its telescopic drive shafts (indicated by reference

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numerals 30, 130 and 132, for example) are for disengaging after the distraction is complete, as recited in Applicants' claim 1. In fact, Landsberger teaches away from the claimed invention by expressly stating not only that the device remains implanted after the desired distraction is obtained, but also that the device remains implanted after the desired distraction is obtained *and* during the following period of bone consolidation (see, e.g., Landsberger at col. 6, lines 42-48; and col. 17, lines 42-45).

Landsberger explicitly distinguishes between the time at which the desired distraction is obtained and the time of satisfactory bone consolidation. Specifically, Landsberger describes that once the desired distraction is obtained, the adjustment nut, shaft and sheath are removed and the remaining, internally implanted, portions of the device (including the telescopic drive shafts) are left in place during the period of bone consolidation. Landsberger defines this period of bone consolidation as "generally two to four months" after the desired distraction has been obtained (see, Landsberger at col. 6, lines 45-46). Thus, Landsberger in fact teaches away from an expansion means . . . for disengaging from the first transmitting means and the second transmitting means after the distraction is complete, as recited in independent claim 1.

Independent method claim 25 recites implanting a first transmitting means onto the first tissue region, implanting a second transmitting means onto the second tissues region, engaging an expansion means with the first and second transmitting means, activating the expansion means to exert a force distracting the first transmitting means from the second transmitting means to create a distraction space for formation of distracted tissue, and disengaging the expansion means from the first transmitting means and the second transmitting means after the distraction is complete.

Landsberger does not teach or suggest disengaging the expansion means from the first transmitting means and the second transmitting means after the distraction is complete as recited in amended independent method claim 25. As discussed above, Landsberger expressly teaches that the entire device remains implanted after the desired distraction is obtained as well as during the period of bone consolidation (see, e.g., Landsberger at col. 6, lines 42-48; and col. 17, lines 42-45). Landsberger therefore can not and does not teach or suggest disengaging the expansion means after the distraction is complete as recited in independent claim 25.

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Claims 2-21 and 24 are dependent on claim 1 and include all of the limitations thereof, and are therefore in condition for allowance for at least the same reasons discussed above with respect to independent claim 1. Likewise, claims 26-28 are dependent upon claim 25 and include all of the limitations thereof, and are therefore in condition for allowance for at least the same reasons discussed above with respect to independent claim 25.

In order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule." If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(b) is improper.

Landsberger thus fails to disclose each and every limitation set forth in claims 1-21 and 24-28. For at least these reasons, the Examiner has failed to establish anticipation of Applicant's claims 1-21 and 24-28 under 35 U.S.C. 102(b). Withdrawal of this rejection is therefore respectfully requested.

#### CONCLUSION

All claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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